



IFW 1617

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of James Hugh McLaughlin ) Group Art Unit  
Serial No: 09/964,143 ) 1617  
Filed: September 25, 2001 ) Examiner  
For: Emollient Skin Conditioning Cream and Method ) Wang, Shengjun

November 14, 2006

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Reply To Examiner's Letter Of August 29, 2006

Dear Sir:

In reply to the Examiner's, Shengjun Wang's Office communication concerning this application or proceeding, please find three copies of Appellant's Reply. One copy for each member of Board of Appeals is enclosed. The Examiner's communication concerns a Request For Admissions attached Appellant's Reply To The Examiner's Answer. The request was directed to Shengjun Wang, her supervisor and the three members of Board of Appeals. Although in Appellant's attorney's opinion the Request For Admissions would clarified the issues in appeals, the Patent Office refused to entertain the request stating "The USPTO rules governing both examination of applications and appeals do not provide for such a submission."

Respectfully submitted,

*Richard N. Miller*

Richard N. Miller  
Registration No. 22,977

Enc.: Three copies of Reply To Examiner's Letter Of August 29, 2006



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,143	09/25/2001	James Hugh McLaughlin	C&E, JHM-1	1702

7590 08/29/2006

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EXAMINER

WANG, SHENGJUN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
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09/964143

APPLICATION NO. CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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20060822

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

The reply brief filed June 20, 2006 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

The appellant has submitted Request for Admissions along with the Reply to the Examiner's Answer seeking a response to the same set of questions from several USPTO employees, including Shengjun Wang, Sreeni Padmanabhan, and Board members. The USPTO rules governing both examination of applications and appeals do not provide for such a submission.

Moreover, the USPTO and the Department of Commerce have promulgated regulations that govern requests for employee testimony, in accordance with the Supreme Court's holding in *United States ex rel. Touhy v. Ragen*, 340 U.S. 462 (1951). See 37 C.F.R. part 104; 15 C.F.R. part 15; see also Manual of Patent Examining Procedure (MPEP) Chapter 1700. Accordingly, the demand for testimony, including request for admissions, from USPTO employees must comply with the USPTO's regulations regarding such demands and are not made under the Federal Rules of Civil Procedure. See generally 37 CFR Part 104; *United States ex rel. Touhy v. Ragen*, 340 U.S. 462 (1951).

The Request for Admissions accompanying your Reply to the Examiner's Answer does not comply with 37 CFR Part 104, e.g., your demand does not include an affidavit setting forth the information required in 37 CFR § 104.22(c)(3) and the MPEP § 1701 and was not properly served under 37 CFR § 104.22(c)(1).

Finally, the appellant stated that if a response to the Request for Admissions "is not timely, the matters set forth therein are deemed admitted." However, because your demand is improper, the USPTO will not provide a response.

As to the fee paid by appellant on September 21, 2004, it appears that applicant has overpaid the extension fee. Applicant may file request for refund.

SHENGJUN WANG  
Primary Examiner  
Art Unit: 1617



**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/964,143  
Filing Date: September 25, 2001  
Appellants: McLAUGHLIN, JAMES HUGH

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Richard N. Miller  
For Appellant

**REPLY TO EXAMINER'S LETTER OF AUGUST 29, 2006**

This is in response to Office communication concerning this application or proceeding filed by Shengjun Wang, Primary Examiner, mailed August 29, 2006, concerning of Request for Admissions accompanying the appellant's Reply to the Answer's Answer

DEMAND FOR ADMISSIONS ATTACHED APPELLANT'S REPLY TO THE  
EXAMINER'S ANSWER

The Request For Admissions attached to Appellant's Reply To The Examiner's Answer was rejected by with Examiner in her communication mailed August 29, 2006, for failure to comply with USPTO and Department of Commerce regulations. Since rejection herein is based upon Examiner's reliance of the teaching in the primary Kellner et al. reference that sodium stearate and calcium stearate are equivalent gelling agents for water; **Appellant maintains in the interest in getting to the truth, anything to contrary, is relevant in interest of justice.**

The Demand For Admissions concerns primary reference, Keller et al's teaching that sodium stearate and calcium stearate are equivalent primary gelling agents (Kellner et al, col. 2, lines 57 - 60 and sequences 6 – 12 in example 1) for water despite the known facts sodium stearate is water soluble and can gel water and calcium stearate is water insoluble and cannot gel water. Further, Appellant verified said facts in an Affidavit Under 37 C.F.R. 132. A chemist skilled in art of making gels in water knows Keller et al's teaching that sodium stearate and calcium stearate are equivalents for gelling water **is not true and would not substitute calcium stearate for sodium stearate in compositions of Keller et al.** To the extent the Examiner herein does not agree, it is Appellant's opinion that the Examiner herein is in denial of the facts and does not qualify an one skilled in art.

Furthermore, it is noted Kellner et al. is an invalid patent because it does not comply with 35 U.S.C. 112. More particularly, all nine examples in Kellner et al. contain from 6% by weight (Examples 2A and 2C) to 13% by weight (Example 1) of butylene glycol. Obviously,

butylene glycol is essential ingredient, yet nowhere in specification is there the discussion of role of butylene glycol . Thus, this patent is invalid because it does not comply with 35 U.S.C. 112 and should have been rejected for failure to comply. The EXAMINERS who were involved in allowance of this application were NEGLIGENT along with ATTORNEYS who prepared the application; and, possibly, the INVENTORS were negligent, too. But, because all nine examples used sodium stearate as the gelling agent, that is more evidence that inventors did not make any composition containing calcium stearate as gelling agent and that error can be attributed to negligence of attorneys or whoever prepared the patent application, too.

The Examiner admits in the Examiners Answer (page 8, lines 7 – 14) that sodium stearate and calcium stearate are not equivalents as Kellner et al teaches stating as follows:

“Kellner et al. teaches that both sodium and calcium stearate are suitable for the composition disclosed therein. See, column 1, lines 57 – 63 and claims 4. **The examiner does not dispute that sodium stearate and calcium stearate are not equivalent as gelling agents in a composition comprising 41% of water as shown in the 1.132 Affidavit.** The examiner contends (page 8, lines 12 – 14, Examiner’s Reply Brief) that it would have been obvious to one of ordinary skill art to use calcium stearate in the composition of Kellner et al., wherein water amount is 5 – 10%.

THE EXAMINER’S ARGUMENT IS RIDICULOUS AND COUNTER TO THE TEACHING OF KELLNER ET AL BECAUSE EXAMPLE 1 OF KELLNER ET AL. CONTAINS 41% WATER AND KELLNER ET AL. TEACHES AT COLUMN 2, LINES 57 – 63 THAT CALCIUM STEARATE CAN BE SUBSTITUTED FOR SODIUM STEARATE.

SINCE THE WATER CONTENT IN KELLNER ET AL'S NINE EXAMPLES RANGES FROM 37.7% TO 45.7%, THE EXAMINER'S ARGUMENT IS ABSURD AND CONTRARY TO TEACHINGS KELLNER ET AL. If calcium stearate cannot substituted for sodium stearate in the composition of Kellner et al.'s Examples 1 or 2A – 2H as Kellner et al. teaches, then that proves Appellant's argument calcium stearate and sodium stearate are not equivalents and rejection under 35 U.S.C. 103 based on Kellner et al. is not valid.

Furthermore, it is noted that all Kellner et al.'s examples contain butylene glycol as an essential ingredient and Appellant's compositions do not contain butylene glycol as a essential ingredient. That is further difference from Kellner et al.

In summary, the foregoing analysis shows Appellant's cosmetic, exfoliating cream comprising, by weight, 40 – 60% emollient oil; 0.4 – 8% water surface active agent, a calcium or magnesium salt C14 – C18 fatty acid wherein weight ratio of the emollient oil to said fatty acid salt is in range the 4:1 to 2.5:1 and adequate to produce to produce of composition in form stable, extrudable paste or cream; 10 – 45% particulate mixture consisting of 8 – 20% starch material admixed particulate selected from group consisting of sodium chloride, pumice, talc and vegetable flour; and 0 – 10% water; is not disclosed or suggested in any fair reading of Kellner et al. because one skilled in art knows that replacement of sodium stearate with calcium stearate in any nine examples of Kellner et al. will not produce a homogeneous composition in gel form because calcium stearate is not soluble in water.

In conclusion, based 20/20 hindsight, the Examiner herein when she searched Appellant's invention discovered Kellner et al. patent which disclosed sodium stearate and calcium

stearate as equivalents for gelling water in seemingly similar composition and rejected Appellant's invention on Kellner et al. patent which had nine Examples containing 37.7 – 45.7% water with sodium stearate as the gelling agent. Appellant produced evidence that calcium stearate is insoluble in water and could not gel water. **The Examiner ignored the evidence and maintained the rejection without proving that calcium stearate could gel water. Furthermore, the evidence showed butylene glycol seemingly was essential ingredient because it was present every example, but nowhere referred to in specification making Kellner et al. patent invalid for not complying with 35 U.S.C. 112 and proving U. S. Patent Office was negligent in issuing the patent.** Furthermore, the attorneys who prepared the patent application were negligent, too. Appellant's attorney in forty years of practice has never encountered of patent with the deficiencies.

Three copies (one for each of three members of the Board Of Appeals) of this reply to Examiners' statement denying the Appellant's Request For Admissions are enclosed. Appellant's attorney considers this paper part of reply to Examiner's Answer' and requests be forwarded to each member of Board of Appeals in interest of justice. Since Appellant's Attorney is not sure whether the Examiner herein will forward this paper to the members of Board of Appeals, Appellant's attorney requests the Examiner to inform Appellant in writing if she elects to not forward paper to the members of Board of Appeals with reasons why she is not forwarding this paper. Appellant's attorney further requests that the decision in this appeal list all Appellant's papers were considered this appeal. Finally, since patent



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application covers a commercial product, Appellant's attorney will recommend that any adverse decision herein be appealed under 35 U.S.C. 145.

Respectfully submitted,

*Richard N. Miller*

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CC: Reply of the Examiner dated August 29, 2006